

replacement compact disc contains no new matter. The compact disc and copy must be labeled “COPY 1 REPLACEMENT MM/DD/YYYY” (with the month, day and year of creation indicated), and “COPY 2 REPLACEMENT MM/DD/YYYY,” respectively.

(5) The specification must contain an incorporation-by-reference of the material on the compact disc in a separate paragraph (§ 1.77(b)(5)), identifying each compact disc by the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes. The Office may require applicant to amend the specification to include in the paper portion any part of the specification previously submitted on compact disc.

(6) A compact disc must also be labeled with the following information:

- (i) The name of each inventor (if known);
- (ii) Title of the invention;
- (iii) The docket number, or application number if known, used by the person filing the application to identify the application;
- (iv) A creation date of the compact disc;
- (v) If multiple compact discs are submitted, the label shall indicate their order (*e.g.*, “1 of X”); and
- (vi) An indication that the disc is “Copy 1” or “Copy 2” of the submission. See paragraph (b)(4) of this section.

(7) If a file is unreadable on both copies of the disc, the unreadable file will be treated as not having been submitted. A file is unreadable if, for example, it is of a format that does not comply with the requirements of paragraph (e)(3) of this section, it is corrupted by a computer virus, or it is written onto a defective compact disc.

(f)(1) Any sequence listing in an electronic medium in compliance with §§ 1.52(e) and 1.821(c) or (e), and any computer program listing filed in an electronic medium in compliance with §§ 1.52(e) and 1.96, will be excluded when determining the application size fee required by § 1.16(s) or § 1.492(j). For purposes of determining the application size fee required by § 1.16(s) or § 1.492(j), for an application the specification and drawings of which, excluding any sequence listing in compliance with

§ 1.821(c) or (e), and any computer program listing filed in an electronic medium in compliance with §§ 1.52(e) and 1.96, are submitted in whole or in part on an electronic medium other than the Office electronic filing system, each three kilobytes of content submitted on an electronic medium shall be counted as a sheet of paper.

(2) Except as otherwise provided in this paragraph, the paper size equivalent of the specification and drawings of an application submitted via the Office electronic filing system will be considered to be seventy-five percent of the number of sheets of paper present in the specification and drawings of the application when entered into the Office file wrapper after being rendered by the Office electronic filing system for purposes of determining the application size fee required by § 1.16(s). Any sequence listing in compliance with § 1.821(c) or (e), and any computer program listing in compliance with § 1.96, submitted via the Office electronic filing system will be excluded when determining the application size fee required by § 1.16(s) if the listing is submitted in ASCII text as part of an associated file.

(Pub. L. 94–131, 89 Stat. 685; 35 U.S.C. 6, Pub. L. 97–247; 15 U.S.C. 1113, 1123)

[43 FR 20462, May 11, 1978]

EDITORIAL NOTE: For FEDERAL REGISTER citations affecting § 1.52, see the List of CFR Sections Affected, which appears in the Finding Aids section of the printed volume and at [www.govinfo.gov](http://www.govinfo.gov).

### § 1.53 Application number, filing date, and completion of application.

(a) *Application number.* Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes.

(b) *Application filing requirements—Nonprovisional application.* The filing date of an application for patent filed under this section, other than an application for a design patent or a provisional application under paragraph (c) of this section, is the date on which a specification, with or without claims, is received in the Office. The filing date of an application for a design patent filed under this section, except for a

continued prosecution application under paragraph (d) of this section, is the date on which the specification as prescribed by 35 U.S.C. 112, including at least one claim, and any required drawings are received in the Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121, 365(c), or 386(c) and § 1.78.

(1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors named in the prior application may be filed under this paragraph or paragraph (d) of this section.

(2) A continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application) or a continuation or divisional application naming an inventor not named in the prior application must be filed under this paragraph.

(c) *Application filing requirements—Provisional application.* The filing date of a provisional application is the date on which a specification, with or without claims, is received in the Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

(1) A provisional application must also include the cover sheet required by § 1.51(c)(1), which may be an application data sheet (§ 1.76), or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section. The grant of such a request for conversion will not entitle applicant to a refund of the fees that were properly paid in the application filed under paragraph (b) of this section. Such a request for conver-

sion must be accompanied by the processing fee set forth in § 1.17(q) and be filed prior to the earliest of:

(i) Abandonment of the application filed under paragraph (b) of this section;

(ii) Payment of the issue fee on the application filed under paragraph (b) of this section; or

(iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section.

(3) A provisional application filed under paragraph (c) of this section may be converted to a nonprovisional application filed under paragraph (b) of this section and accorded the original filing date of the provisional application. The conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. Conversion of a provisional application to a nonprovisional application under this paragraph will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested. Thus, applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e), rather than converting the provisional application into a nonprovisional application pursuant to this paragraph. A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by 35 U.S.C. 112(b), unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed by 35 U.S.C. 112(b). The nonprovisional application resulting from conversion of a provisional application must also include the filing fee, search fee, and examination fee for a nonprovisional application, and the surcharge required by § 1.16(f) if either the basic filing fee for a nonprovisional application or the inventor's oath or declaration was not

present on the filing date accorded the resulting nonprovisional application (*i.e.*, the filing date of the original provisional application). A request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

(i) Abandonment of the provisional application filed under paragraph (c) of this section; or

(ii) Expiration of twelve months after the filing date of the provisional application filed under paragraph (c) of this section.

(4) A provisional application is not entitled to the right of priority under 35 U.S.C. 119, 365(a), or 386(a) or § 1.55, or to the benefit of an earlier filing date under 35 U.S.C. 120, 121, 365(c), or 386(c) or § 1.78 of any other application. No claim for priority under 35 U.S.C. 119(e) or § 1.78(a) may be made in a design application based on a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

(d) *Application filing requirements—Continued prosecution (nonprovisional) application.* (1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The application is for a design patent;

(ii) The prior nonprovisional application is a design application, but not an international design application, that is complete as defined by § 1.51(b), except for the inventor's oath or declaration if the application is filed on or after September 16, 2012, and the prior nonprovisional application contains an application data sheet meeting the conditions specified in § 1.53(f)(3)(i); and

(iii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under § 1.313(c) is granted in the prior application;

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.

(2) The filing date of a continued prosecution application is the date on which a request on a separate paper for an application under this paragraph is filed. An application filed under this paragraph:

(i) Must identify the prior application;

(ii) Discloses and claims only subject matter disclosed in the prior application;

(iii) Names as inventors the same inventors named in the prior application on the date the application under this paragraph was filed, except as provided in paragraph (d)(4) of this section;

(iv) Includes the request for an application under this paragraph, will utilize the file jacket and contents of the prior application, including the specification, drawings and the inventor's oath or declaration from the prior application, to constitute the new application, and will be assigned the application number of the prior application for identification purposes; and

(v) Is a request to expressly abandon the prior application as of the filing date of the request for an application under this paragraph.

(3) The filing fee, search fee, and examination fee for a continued prosecution application filed under this paragraph are the basic filing fee as set forth in § 1.16(b), the search fee as set forth in § 1.16(l), and the examination fee as set forth in § 1.16(p).

(4) An application filed under this paragraph may be filed by fewer than all the inventors named in the prior application, provided that the request for an application under this paragraph when filed is accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of correction of inventorship under § 1.48.

(5) Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application

under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125.

(6) The filing of a continued prosecution application under this paragraph will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public, who is entitled under the provisions of § 1.14 to access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of this paragraph, may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket.

(7) A request for an application under this paragraph is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. No amendment in an application under this paragraph may delete this specific reference to any prior application.

(8) In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability:

- (i) Title of invention;
- (ii) Name of applicant(s); and
- (iii) Correspondence address.

(9) See § 1.103(b) for requesting a limited suspension of action in an application filed under this paragraph.

(e) *Failure to meet filing date requirements.* (1) If an application deposited under paragraph (b), (c), or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified, if a correspondence address has been provided, and given a period of time within which to correct the filing error. If, however, a request for an application under paragraph (d) of this section does not meet the requirements of that paragraph because the applica-

tion in which the request was filed is not a design application, and if the application in which the request was filed was itself filed on or after June 8, 1995, the request for an application under paragraph (d) of this section will be treated as a request for continued examination under § 1.114.

(2) Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f). In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

(3) If an applicant is notified of a filing error pursuant to paragraph (e)(1) of this section, but fails to correct the filing error within the given time period or otherwise timely (§ 1.181(f)) take action pursuant to this paragraph, proceedings in the application will be considered terminated. Where proceedings in an application are terminated pursuant to this paragraph, the application may be disposed of, and any filing fees, less the handling fee set forth in § 1.21(n), will be refunded.

(f) *Completion of application subsequent to filing—Nonprovisional (including continued prosecution or reissue) application.*

(1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, search fee, or examination fee, or if an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include at least one claim or the inventor's oath or declaration (§§ 1.63, 1.64, 1.162, or 1.175), and the applicant has provided a correspondence address (§ 1.33(a)), the applicant will be notified and given a period of time within which to file a claim or claims, pay the basic filing fee, search fee, and examination fee, and pay the surcharge if required by § 1.16(f), to avoid abandonment.

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(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the basic filing fee, search fee, examination fee, at least one claim, or the inventor's oath or declaration, and the applicant has not provided a correspondence address (§ 1.33(a)), the applicant has three months from the filing date of the application within which to file a claim or claims, pay the basic filing fee, search fee, and examination fee, and pay the surcharge required by § 1.16(f), to avoid abandonment.

(3) The inventor's oath or declaration in an application under § 1.53(b) must also be filed within the period specified in paragraph (f)(1) or (f)(2) of this section, except that the filing of the inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance under the conditions specified in paragraphs (f)(3)(i) and (f)(3)(ii) of this section.

(i) The application must be an original (non-reissue) application that contains an application data sheet in accordance with § 1.76 identifying:

(A) Each inventor by his or her legal name;

(B) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

(ii) The applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee for the patent is paid. If the applicant is notified in a notice of allowability that an oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with § 1.63, or substitute statement in compliance with § 1.64, no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under § 1.136 (see § 1.136(c)). The Office may dispense with the notice provided for in paragraph (f)(1) of this section if each required oath or declaration in compli-

ance with § 1.63, or substitute statement in compliance with § 1.64, has been filed before the application is in condition for allowance.

(4) If the excess claims fees required by § 1.16(h) and (i) and multiple dependent claim fee required by § 1.16(j) are not paid on filing or on later presentation of the claims for which the excess claims or multiple dependent claim fees are due, the fees required by § 1.16(h), (i), and (j) must be paid or the claims canceled by amendment prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency. If the application size fee required by § 1.16(s) (if any) is not paid on filing or on later presentation of the amendment necessitating a fee or additional fee under § 1.16(s), the fee required by § 1.16(s) must be paid prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(5) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and to continuation-in-part applications under paragraph (b) of this section. See § 1.63(d) concerning the submission of a copy of the inventor's oath or declaration from the prior application for a continuing application under paragraph (b) of this section.

(6) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.

(g) *Completion of application subsequent to filing—Provisional application.*

(1) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing fee (§ 1.16(d)), and applicant has provided a correspondence address (§ 1.33(a)), applicant will be notified and given a period of time within which to pay the basic filing fee, file a cover sheet (§ 1.51(c)(1)), and pay the surcharge required by § 1.16(g) to avoid abandonment.

(2) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing

fee (§1.16(d)), and applicant has not provided a correspondence address (§1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, file a cover sheet (§1.51(c)(1)), and pay the surcharge required by §1.16(g) to avoid abandonment.

(3) If the application size fee required by §1.16(s) (if any) is not paid on filing, the fee required by §1.16(s) must be paid prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(4) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.

(h) *Subsequent treatment of application—Nonprovisional (including continued prosecution) application.* An application for a patent filed under paragraphs (b) or (d) of this section will not be placed on the files for examination until all its required parts, complying with the rules relating thereto, are received, except that the inventor's oath or declaration may be filed when the application is otherwise in condition for allowance pursuant to paragraph (f)(3) of this section and minor informalities may be waived subject to subsequent correction whenever required.

(i) *Subsequent treatment of application—Provisional application.* A provisional application for a patent filed under paragraph (c) of this section will not be placed on the files for examination and will become abandoned no later than twelve months after its filing date pursuant to 35 U.S.C. 111(b)(1).

[62 FR 53186, Oct. 10, 1997, as amended at 63 FR 5734, Feb. 4, 1998; 65 FR 14871, Mar. 20, 2000; 65 FR 50104, Aug. 16, 2000; 65 FR 54665, Sept. 8, 2000; 65 FR 78960, Dec. 18, 2000; 68 FR 14336, Mar. 25, 2003; 68 FR 32380, May 30, 2003; 69 FR 29878, May 26, 2004; 69 FR 56539, Sept. 21, 2004; 70 FR 3890, Jan. 27, 2005; 70 FR 30365, May 26, 2005; 72 FR 46836, Aug. 21, 2007; 74 FR 52688, Oct. 14, 2009; 77 FR 48817, Aug. 14, 2012; 78 FR 11053, Feb. 14, 2013; 78 FR 62398, Oct. 21, 2013; 79 FR 12386, Mar. 5, 2014; 80 FR 17956, Apr. 2, 2015]

#### § 1.54 Parts of application to be filed together; filing receipt.

(a) It is desirable that all parts of the complete application be deposited in the Office together; otherwise, a letter

must accompany each part, accurately and clearly connecting it with the other parts of the application. See §1.53 (f) and (g) with regard to completion of an application.

(b) Applicant will be informed of the application number and filing date by a filing receipt, unless the application is an application filed under §1.53(d). A letter limited to a request for a filing receipt may be signed by a juristic applicant or patent owner.

[62 FR 53188, Oct. 10, 1997, as amended at 78 FR 62399, Oct. 21, 2013]

#### § 1.55 Claim for foreign priority.

(a) *In general.* An applicant in a nonprovisional application may claim priority to one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, 365(a) and (b), and 386(a) and (b) and this section.

(b) *Time for filing subsequent application.* The nonprovisional application must be:

(1) Filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, subject to paragraph (c) of this section (a subsequent application); or

(2) Entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of a subsequent application that was filed within the period set forth in paragraph (b)(1) of this section.

(c) *Delayed filing of subsequent application.* If the subsequent application has a filing date which is after the expiration of the period set forth in paragraph (b)(1) of this section, but within two months from the expiration of the period set forth in paragraph (b)(1) of this section, the right of priority in the subsequent application may be restored under PCT Rule 26bis.3 for an international application, or upon petition pursuant to this paragraph, if the delay in filing the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. A petition to restore the right of priority under this paragraph filed on or after May 13, 2015, must be filed in the subsequent application, or in the earliest nonprovisional application claiming benefit under 35 U.S.C.